

SEP 07 2006

REMARKS

Claims 1-6 and 8-12 are pending in the application, and independent Claims 1 and 10 have been amended. Support for all amendments can be found in the specification as originally filed. No new matter has been added.

Applicants would like to thank the Examiner for careful consideration of this application and continued patience in its prosecution. Applicant's representative would also like to thank for the teleconference of September 5, 2006. During the teleconference, the Examiner and Applicant's representative discussed the surprising results exhibited by Applicant's polyurethanes, and considered amendments that would allow the pending application to pass to issue. The Examiner suggested that the Applicant's amend the independent Claims to recite a numerical limitation exhibited by the Applicant's polyurethanes. Accordingly, Applicants have done so herein.

Rejection under 35 USC 103

Claims 1-6 and 8-12 stand rejected under 35 USC 103(a) as being unpatentable over US Patent No. 4,079,028 to Emmons et al. (hereinafter "Emmons").

The Examiner alleges that the polyurethane thickeners of amended independent Claim 1 are commensurate in scope with those of Emmons. Applicants respectfully disagree.

It is well settled that to establish a *prima facie* case of obviousness, the USPTO must satisfy all of the following requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification has a reasonable expectation of success, as determined from the vantage point of one of ordinary skill in the art at the time the invention was made. *Amgen v. Chugai Pharmaceutical Co.* 18 USPQ 2d 1016, 1023 (Fed Cir, 1991), *cert. denied* 502 U.S. 856 (1991). Third, the prior art reference or combination of references must teach or suggest all of the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496, (CCPA 1970).

Applicants submit that Emmons fails to teach or suggest a polyurethane thickener of amended independent Claim 1 or a method for producing such a polyurethane thickener as recited in independent Claim 10 because Emmons fails to teach or suggest a polyurethane thickener having a shear viscosity of from 5100 mPa·s and 28000 mPa·s. In particular, the polyurethane thickeners of Emmons are reported in Table 16, between columns 29 and 30 as having shear viscosities of between 61 and 141 KU. Applicants polyurethane thickeners exhibit shear viscosities of between 400 and 28000 mPa·s or 64 to 244 KU. Accordingly, Applicants have further defined the shear viscosity of the claimed polyurethane thickeners to from 5100 to 28000 mPa·s or 142 to 244 KU which is outside the shear viscosity range exhibited by Emmons. Support for this amendment can be found on page 16, Table 3 of the application as originally filed.

Moreover, Emmons fails to provide any teaching or suggestion that would allow the skilled artisan to prepare a polyurethane thickener having the recited shear viscosity. As discussed in the Response and Amendment of May 30, 2006, Emmons fails to teach or suggest the step of "the partial reaction of the polyethers a1) with at least one organic isocyanate having a functionality of ≥ 2 and about 10 mole % to 50 mole % of the polyethers a1) are reacted with isocyanates", and fails to provide a method by which the shear viscosity may be improved. Therefore, Emmons fails to provide a reasonable expectation for successfully preparing a polyurethane thickener having the properties recited in amended independent Claim 1.

Accordingly, Emmons fails to teach or suggest all of the limitations of amended independent Claims 1 and 10 and fails to provide a reasonable expectation of successfully preparing a polyurethane thickener having the claimed shear viscosity. Therefore, Emmons fails to render obvious amended independent Claims 1 and 10.

Claims 2-6 and 8-12 either directly or indirectly depend from and add further limitations to amended independent Claims 1 and 10 and are, respectfully, deemed to be allowable for at least the same reasons in combination with amended independent Claims 1 and 10. Reconsideration and withdrawal of the Examiner's rejection is respectfully requested.

Double Patenting

Claims 1-6 and 8-12 stand provisionally rejected under the judicially created doctrine of obviousness type double patenting over US Patent Application No. 10/092077 to Wamprecht et al. (hereinafter "Wamprecht '077").

Applicants submit that Wamprecht '077 has been abandoned. Accordingly, the Examiner's double patenting rejection of the current claimed invention is rendered moot.

Claims 1-6 and 8-12 stand rejected under the judicially created doctrine of obvious-type double patenting over Claims 1-12 of US Patent No. 6,642,302 to Wamprecht et al. (hereinafter "Wamprecht '302").

Applicants respectfully traverse this ground for rejection. However in order to expedite prosecution of this application, Applicants are submitting a terminal disclaimer in compliance with 37 CFR 1.321(c) hereto. Accordingly, Applicants request withdrawal of this ground of rejection.

Applicants believe that in view of the above amendments and remarks the pending claims are in condition for allowance and respectfully request notice to such effect. Should the Examiner have any questions regarding this Application he is invited to initiate a phone conversation with the undersigned at his convenience.

Respectfully submitted,

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